

REMARKS

Claims 1-13 are canceled. New Claims 14-24 are added. An amended Figure 2 is provided concurrently with this submission to correct a typographical error. Support for these claims is to be found in the specification as indicated in the discussion below. Certain purely formal amendments to the Specification have been made as set forth above. No new matter is added.

In brief, the claimed invention comprises a system for on-line shopping by which a customer may identify goods for purchase from an on-line merchant and, in a separate transaction, may make payment at a store not affiliated with the customer or the on-line merchant. The references cited by the Examiner as anticipating the claimed invention do not include this feature.

According to the claimed invention, and as described in Figure 5 and elsewhere, an on-line shopping session takes place via a first terminal or user terminal 2A at the user's home or another place of the user's choosing, which is connected to a commerce provider server 3 via the Internet or another network 1. (Claims 14, 15, 18, 19, 20, 21, 22, and 24) Once the user has selected goods for purchase, the commerce provider server issues an identification number to the user to identify the transaction so that settlement can be made at a store, which need not be affiliated with the on-line merchant. (Claims 14, 18, 20, 22) The identification number issued to the user by the commerce provider server may be input to a second terminal or multimedia terminal 2B to identify the specific transaction and the amount due so that payment can be made at the site of the second terminal. Payment may thus occur at a location not subject to the control of the user or the merchant. (Claims 14, 18, 20, 22) Nothing in the claims would prevent a single facility from acting as a commerce provider server for multiple on-line merchants. Nor would anything in the claims prevent a single store from acting as a second terminal or multimedia terminal location for multiple commerce provider servers, such as may happen if a convenience store, for example, arranges to serve as a place of payment serving multiple on-line merchants or multiple commerce provider servers.

Claims 1-13 were rejected pursuant to 35 U.S.C. § 102(b) as anticipated by Japanese Patent No. 06-060100 to Hosomi et al. and Japanese Patent No. 11-339076 to Nishihata. In addition, Claims 9-13 were rejected pursuant to 35 U.S.C. § 103(a),

in part as obvious in view of U.S. Patent No. 6,058,373 to Blinn et al. and in part as obvious in view of the Examiner's assertion of knowledge of alleged practices of a well-known retailer, unsupported by citation to any reference work. As discussed above, the claimed invention concerns transactions in which ordering and payment may occur through different systems, such that the system through which payment is effected is not required to be subject to the control of the customer or the on-line merchant. Hosomi et al. and Nishihata, by contrast, concern transactions in which ordering and payment occur within the same system. In addition, the claimed invention covers merchandise transactions, while Hosomi et al. concerns ticket reservations and Nishihata concerns boarding cards. The claimed invention is not anticipated by Hosomi et al. or Nishihata and should be allowed.

Subsequent to the mailing of the office action to which this paper responds, Applicant obtained and submitted English translations of the full text of Japanese Hosomi et al. and Nishihata, which previously had been available in English only in abstract form. The full text of Hosomi et al. and Nishihata is discussed below in connection with new Claims 14-24.

The Examiner also rejected Claims 9-13 under 35 U.S.C. § 103(a) on the basis that the claimed invention is obvious in view of U.S. Patent No. 6,058,373 to Blinn et al. In making this rejection, the Examiner appears to have misapprehended Applicant's previously presented arguments distinguishing Blinn et al. from the claimed invention. It is implicit in Blinn et al. that payment for the goods identified for purchase are made to the on-line merchant offering them for sale, and Blinn et al. does not teach a separation of the on-line shopping session from a subsequent payment session. The claimed invention, by contrast, involves a separate payment transaction, which may be at a store unaffiliated with the on-line merchant. The claimed invention is not obvious in view of Blinn et al. and should be allowed. Blinn et al. is further discussed below in connection with new Claims 14-24.

In addition, the Examiner dismissed the at-store payment feature of the claimed invention by asserting, without reference, that the retailer Circuit City allows customers to order off-line and pay at one of the retailer's stores. Applicant traverses the Examiner's improper assertion of technical fact in an area of esoteric technology without support by citation of any reference work. *See* MPEP 2144.03 (citing *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 422-21 (CCPA 1970)). In addition,

Applicant notes that even if the Examiner's assertion had not been improper, the Circuit City example does not support the conclusion reached by the Examiner, because the example does not involve customers ordering on-line and paying at a store operated by someone unaffiliated with the on-line merchant and connected to the on-line merchant only by means of a customer provider server accessible via a network.

Applicant respectfully traverses the rejection of Claims 1-13 for reasons explained above. Notwithstanding this traversal, and in response to the Examiner's comments, Applicant cancels claims 1-13 and adds new claims 14-24, as set forth above and discussed below.

Claims 14-17

With regard to independent claim 14, the main features of claim 14 are as follows:

(1) A system is provided with two terminals, i.e., a first and a second terminal. Said second terminal can provide various kinds of services and may be located at a store accessible by anyone.

(2) Said system permits information relating to a selected service to be stored according to an identification number in the commerce provider server. (Specification, page 7, lines 7-9). Thus, information relating to a service selected at the first terminal is stored with a user identification number in the commerce provider server. When the user identification number is subsequently input from a second terminal to the commerce provider server, information stored as related to the identification number may be transmitted from the commerce provider server to the second terminal, instead of back to the first terminal.

Claims 15-17 depend from claim 14 and add features such as: the ability to use the Internet as the network through which the first and second terminals, and the commerce provider server, are connected (claim 15); the ability to use the claimed invention in connection with a combination of information transmitted by the first terminal to the commerce provider server and retrieved by the second terminal from the commerce provider server (claim 16); and the ability for the second terminal to print such combined information (claim 17).

Support for new Claims 14-17 is to be found in Figures 5 and 7 and in the Specification at page 6, line 26, through page 7, line 25; at page 6, line 28; at page 8, lines 3-11; and at page 8, lines 12-18.

Claims 18-19

With regard to independent claim 18, the main features of claim 18 are as follows:

(1) A method is provided, according to which information of a plurality of services may be transmitted by the use of two terminals, i.e., a first and a second terminal. Said second terminal may provide various kinds of services and may be located at a store accessible by anyone.

(2) According to said method, information relating to a selected service is stored according to an identification number in the commerce provider server. Thus, information relating to a service selected at the first terminal is stored with a user identification number in the commerce provider server. When the user identification number is subsequently input from a second terminal to the commerce provider server, information stored as related to the identification number may be transmitted from the commerce provider server to the second terminal, instead of back to the first terminal.

Claim 19 depends from claim 18 and adds the ability to use the Internet as the network to which the first and second terminals, and the commerce provider server, are connected.

Support for new Claims 18-19 is to be found in Figure 5 and in the Specification at page 6, line 26, through page 7, line 25; and at page 6, line 28.

Claims 20-21

With regard to independent claim 20, the main features of claim 20 are as follows:

(1) A method is provided, according to which information of a service selected by a first terminal may be stored in a commerce provider server according to an identification number.

(2) According to said method, said commerce provider server may receive such identification number via a network from a second terminal, located at a store, which is different from said first terminal.

(3) Also according to said method, information stored in said commerce

provider server by said first terminal may be transmitted to said second terminal in accordance with said received identification number.

Claim 21 depends from claim 20 and adds the ability to use the Internet as the network to which the first and second terminals, and the commerce provider server, are connected.

Support for new Claims 20-21 is to be found in Figure 5 and in the Specification at at page 6, line 28.

Claims 22-24

With regard to independent claim 22, the main features of claim 22 are as follows:

(1) A method is provided, according to which information is combined at a first terminal and transmitted with an identification number from said first terminal to a commerce provider server.

(2) According to said method, said commerce provider server stores said identification number in accordance with said received identification number.

(3) Also according to said method, said information number may subsequently be transmitted to said commerce provider server from a second terminal, located at a store, which second terminal provides a plurality of services and is different from the first terminal.

(4) Finally, according to said method, said combined information transmitted by said first terminal to said commerce provider server may be transmitted from such commerce provider server to said second terminal.

Claims 23-24 depend from claim 22 and add features such as: the ability for the combined information to comprise combined images which may be printed at the second terminal (Claim 23); and the ability to use the Internet as the network to which the first and second terminals, and the commerce provider server, are connected (Claim 24).

Support for new Claims 22-24 is to be found in Figure 7 and in the Specification at page 8, lines 12-18; and at page 6, line 28.

Claims 14-24 Are Not Anticipated by, and Are Patentable over, Prior Art

A review of Hosomi et al. and Nishihata shows that these patents do not undermine the patentability of the claimed invention, either individually or in combination.

In Hosomi et al., the ticket reservation terminal 4, the ticket issuing terminal 7, and the ticket reservation center 1 appear to have been taken by the Examiner to correspond to the first terminal, the second terminal, and the commerce provider server, respectively, of the claimed invention. However, since the ticket issuing terminal 7 provides a single service such as a ticket issuing service, the ticket issuing terminal 7 never corresponds to the second terminal of the claimed invention, which provides a plurality of services. As a result, the claimed invention is not anticipated by Hosomi et al.

In Nishihata, the universal computer 13, the boarding issuing machine 15, and the host computer 11 appear to have been taken by the Examiner to correspond to the first terminal, the second terminal, and the commerce provider server, respectively, of the claimed invention. However, since the boarding issuing machine 15 of Nishihata provides a single service such as boarding issuance, the boarding issuing machine does not correspond to the second terminal of the claimed invention, which provides a plurality of services.

Both Hosomi et al. and Nishihata concern dedicated ticket issuing services and, accordingly, are not concerned with combining information, as in Claims 16 and 22 of the claimed invention, or with the printing of combined information, as in Claims 17 and 23 of the claimed invention. Similarly, Blinn et al., discussed above, does not relate to combined information or the printing of combined information.

In independent Claims 14, 18, 20, and 22, the commerce provider server stores information of a service selected from information of a plurality of services according to an identification number. Such information may be obtained by inputting the identification number to the second terminal. As a result, time spent by the user at a multimedia terminal, or second terminal, in a store is shortened, which increases the efficiency of the on-line shopping system. (Specification, page 8, lines 20-22)

Blinn et al., discussed above, comprises flexible blackboards which allow merchants to add sales information which are called key-value pairs. The system of Blinn et al., however, relates only to a single service (on-line shopping) and therefore makes no use of a second terminal providing a plurality of services such as, *inter alia*, ticket issuance or image printing, as in the claimed invention. Nor does Blinn et al. foresee a second terminal located in a store, as in independent Claims 14, 18, 20, and 22 of the claimed invention. In addition, because independent Claims 14, 18, 20, and

22 provide for information concerning a selected service to be stored by a first terminal in the commerce provider server according to an identification number, a user can accept the selected service by inputting the identification number to a second terminal without carrying out a special selecting operation. Thus, a user's burden and time spent at the second terminal are reduced. Such reduction in burden and time has the effect, *inter alia*, of minimizing the formation of waiting lines associated with on-line shopping transactions at second terminals located in stores.

Conclusion

In view of the foregoing, it is respectfully requested that the application be reconsidered, that Claims 14-24 be allowed, and that the application be passed to issue. Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

A provisional petition is hereby made for any extension of time necessary for the continued pendency during the life of this application. Please charge any fees for such provisional petition and any deficiencies in fees and credit any overpayment of fees for the petition or for entry of this amendment to Attorney's Deposit Account No. 50-2041 (Whitham, Curtis & Christofferson P.C.).

Respectfully submitted,



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ANNOTATED MARKED-UP
DRAWINGS

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Fig. 2 PRIOR ART

